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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/764,194

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Roberto Edmundo Pazmino Sanchez

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EXAMINER

LAUX, JESSICA L

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/764,194	Applicant(s) SANCHEZ, ROBERTO EDMUNDO PAZMINO	
	Examiner JESSICA LAUX	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement is made of the amendment filed 02/15/2008.

Accordingly the application has been amended.

Response to Arguments

Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

Election/Restrictions

Newly submitted claim 10 is directed to an species invention that is independent or distinct from the invention originally claimed for the following reasons: the species in claim 10 recites an embodiment requiring spring connectors and not metal plates for connection.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 10 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jazzar (7121061) in view of Reay (5671582).

Regarding claims 1 and 9: Jazzar a modular building system comprising:

(a) multiple modules (16 or 17), wherein each of said multiple modules comprise:

- (i) structural steel mesh (28) comprising a backbone and two fins
(while not expressly disclosed it is common and notoriously well known to include reinforcing mesh in the body of the panel);
- (ii) cementitious mortar encasing said backbone and said two fins of said structural steel mesh and yielding six sides and eight edges of said module (figures 2 or 9);

(c) reinforcing steel mesh (the cross bars as shown at 28).

Jazzar does not expressly disclose indentations in said six sides and said eight edges of said cementitious mortar, exposing portions of said structural steel mesh or metal plate connectors, but instead discloses that the reinforcing is exposed for connection to an adjacent module.

Reay discloses cementitious panels having indentations (6) exposing portions of said structural steel mesh and metal plate connectors (30) which are connected to said exposed portions of said structural steel mesh thereby connecting adjacent modules (Col. 3, lines 6-14).

It would have been obvious at the time the invention was made to modify the connection design of Jazzar to have exposed portion of structural steel mesh

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connected with plate connectors to create a strong and secure connection that is available for use in various applications.

Further it is noted that both references disclose designs and methods for connecting adjacent pre-cast panels with reinforcing and it has been held that the substitution of one known element or method for another would be obvious if it yields predictable results; in the instant case the substitution of the connection system of Jazzar for that of Reay yields the predictable results of a securely connected pre-cast panel with reinforcing.

It should be noted that the limitation of "said metal plate connectors are welded to" of claim 1 and "soldered...tied" of claim 9 are considered product-by-process limitations in an apparatus claim. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985). In the instant case applicants' claimed product is the same as or obvious over Jazzar in view of Reay as the final product of a panel with steel mesh and plate connectors for connecting exposed product of the mesh does not depend on welding for connecting the steel plate to the mesh; nor does it depend on how the reinforcing and structural mesh were connected.

Regarding claim 2: Jazzar in view of Reay discloses the modular building system of claim 1 above, but does not expressly disclose the dimensions of the

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backbone and fins. However, applicant has not disclosed that the claimed dimensions provide an advantage or solve a stated problem. Furthermore it appears that the fins of Jazzar and applicants claimed fins would perform the same function of strengthening the module and providing a secure connection means equally well. Further it is noted that the modules of Jazzar and applicant's claimed invention are for the purposes of building structures, and therefore would be subject to size limitations and requirements based on the design and function of the building, and that these limitations would vary depending upon the loads subjected to the modules. Therefore it appears to be a mere matter of design choice that would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the fins of Jazzar to have the claimed dimensions.

Regarding claim 3: Jazzar in view of Reay disclose the modular building system of claim 1 above, but do not expressly disclose epoxy resin on said edges of said module in contact with an adjacent module. However, Jazzar does disclose adding concrete between adjacent modules for connecting (Col. 3, lines 42-46). Further applicant discloses in the specification, paragraph 0044 that one of ordinary skill in the art would recognize that other bonding materials may be used. Based upon the level of common sense and ordinary skill in the art and applicants own disclosure it appears that it would have been obvious to substitute epoxy resin for concrete, for cost and availability considerations, to achieve the predictable results of securely connecting adjacent modules.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeanette E Chapman/
Primary Examiner, Art Unit 3633

/J. L./
Examiner, Art Unit 3635